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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/802,472	02/18/97	KORMANIK	C

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QM12/1206

EXAMINER

LUBY, M

ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 12/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/802,472

Applicant(s)
Kormanik, Jr.

Examiner
Matthew Luby

Group Art Unit
3721



☒ Responsive to communication(s) filed on Aug 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5 and 8-31 is/are pending in the application.

Of the above, claim(s) 1-4 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 5 and 8-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Claims 1-4 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 9 and affirmed in Paper No. 14.

Claim Objections

2. Claims 27-30 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from a cancelled claim (namely claims 6 and 7). See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections - 35 USC § 112

3. Claims 5, 8-26, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “from the group consisting of an icon and a symbol” (claim 5, lines 4-5) is indefinite. The language amounts to an improper Markush group, one which does not specify the particular species of the replica. It is suggested that the claim be amended to properly recite the

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elements of the group or the language be deleted from the claim so that applicant might more particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The new recitation “so as not to suggest the article” (claim 5, lines 6-7) is considered vague and indefinite because it is unclear what kind or type of shape, if any, would or would not suggest the article. In general applicant’s use of the term “suggest” (claim 5, lines 8 and 16) fails to positively recite any relevant structure or function of the claimed article and thereby render the claims vague and indefinite. This is also the case in claim 5, lines 8 and 16; claim 24, line 8; claim 25, lines 3, 7, 9, 11; claim 26, lines 3-4, 7, 9, 11.

The new recitation “an activity in which the article can be used” (claim 5, line 8) is vague and indefinite because it is unclear which activity the article can be used with. Further, it has been held that the recitation that an element “can” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Lines 12-13 of claim 5 are unclear because it is not understood where the beginning of the bracket to delete the words by the amendment is intended to be. The end bracket is located after the word “shape” (claim 5, line 13).

It is vague as to what applicant intends to claim by the recitation “marketing the article with the package...” (claim 5, line 15) because no marketing steps have been recited. Note that all products are “marketed”.

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The recitation “a shape that is suggestive of an activity” (claim 5, line 8) is vague and indefinite. It is uncertain as to which shape is suggestive and which is not.

The recitation “the step of constructing the replica to have additional utility includes...” (claim 22, lines 1-2) lacks proper antecedent basis.

The recitation “constructing the replica to be capable of...” (claim 22, line 3) is vague and indefinite because it has been held that the recitation that an element “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Claim 22 is vague and indefinite for failing to point out what “constructing ...to be capable of receiving...writing”. It is uncertain as to exactly which surface can receive writing and which cannot.

The recitation “from the group including a wiping cloth, a rain coat...” (claim 24, lines 4-5) is indefinite. The language amounts to an improper Markush group, one which does not specify the particular species of the object. It is suggested that the claim be amended to properly recite the elements of the group or the language be deleted from the claim so that applicant might more particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that the aforementioned are merely examples to make the applicant aware that in general the claims of record are replete with vague and indefinite limitations and no coherent method can be pieced together with which to make a rejection. It is suggested that applicant

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thoroughly review all limitations within the claims and re-write them to positively set forth all method steps as well as functional and structural limitations.

Claim Rejections

4 Since there is a great deal of uncertainty and confusion as to the exact limitations recited in claims 5 and 8-31 , no art rejection has been applied thereto. See MPEP 2173.06.

Response to Arguments

5 Applicant's arguments filed 08/06/99 have been fully considered but they are not persuasive.

With regard to applicant's comments on pages 6 and 7 that the Office Action is not clear as to how the claims are being interpreted and to the arguments in regard to the references Gelinas, Agapiou, Danforth, Gilstrap and Swatek all art rejections have been withdrawn. The claims of record are solely rejected under 112, 2nd paragraph (as indicated above) because no clear understanding of what applicant intends to claim can be drawn. Additionally, the indication of Allowability of claims 6 and 7 (Paper #9) is withdrawn as the new claims 25-31 present a great deal of uncertainty and confusion as pointed out in the 112, 2nd paragraph rejections above.

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Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Luby whose telephone number is (703) 305-0441. The examiner can normally be reached weekdays from 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo, can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

m.l.

December 3, 1999



PETER VO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700